

REMARKS

Claims 1-10, 12-15, and 17-21 are now in the application. Claim 1 has been amended to recite “wherein (2) includes adhesion with heating and curing with heating”. In view of this amendment to claim 1, claim 11 has been cancelled without prejudice or disclaimer. In addition, claims 1, 2 and 10 have been amended by deleting the term “step”. Claim 16 has also been cancelled without prejudice or disclaimer. Newly presented claim 21 finds support at page 6, lines 15 and 16 of the specification. The amendments to the claims and newly presented claims do not introduce any new matter.

The rejection of claims 2, 17, 18 and 20 under 35 USC 112, second paragraph has been obviated by the amendments to claims 1 and 2.

The rejection of Claim 16 under 35 USC 102(b) as being anticipated by US Patent 6,106,684 to Kawakami et al. has been rendered moot by its cancellation.

The provisional rejection of claims 1-20 under the judicially created doctrine of obviousness type double patenting as being unpatentable over claims 1, 4 and 6-9 of US Patent Application 10/528,154 has been overcome by the filing of a Terminal Disclaimer. The filing of the Terminal Disclaimer is not to be construed as an admission, estoppel or acquiescence. See *Quad Environmental Technology v. Union Sanitary District*, 20 USPQ2d 1392 (Fed. Cir. 1991) and *Ortho Pharmaceuticals Corp. v. Smith*, 22 USPQ2d 1119 (Fed. Cir. 1992).

Claims 1-15 and 17-20 were rejected under 35 USC § 103 (a) as being unpatentable over US Patent 5,676,812 to Kadokura in view of US Patent 6,106,684 to Kawakami et al. The cited references do not render obvious the present invention.

As appreciated by the Examiner, Kadokura fails to teach a hydratable functional group-and unsaturated bond-containing cationic resin composition as recited in the present claims. Kawakami et al. was relied upon for a disclosure of a hydratable functional group-and unsaturated bond-containing cationic resin composition. However, Kawakami et al. do not render obvious the present invention since, among other things, Kawakami et al. do not disclose using the cationic resin composition recited in claim 1 as an adhesive. Kawakami et al. disclose that

their compositions are to be used as coatings. The mere fact that a composition provides a coating on a substrate does not mean or suggest that it would be useful as an adhesive. A coating needs to adhere to only one surface; whereas, an adhesive needs to be capable of joining two separate substrates or surfaces together. Accordingly, an adhesive requires properties that are not required from coatings. Persons skilled in the art concerned with problems addressed by the present invention would not be lead to use compositions that are only suggested as being suitable for coatings.

In addition, the present invention exhibits excellent adhesion to a conductive material. Specifically, an adhesive composition according to the present invention includes a hydratable functional group- and unsaturated bond-containing cationic resin composition. According to this, it is considered that a state like a covalent bond is formed between a hydratable functional group and metal atoms in a conductive material surface. Therefore, to say nothing of a high cohesion in an adhesive resin layer, the present invention exhibits strong adhesiveness between a conductive material and the adhesive resin layer. Please see the paragraph bridging pages 6 and 7 of the specification and the last paragraph on page 31 of the specification.

Furthermore, with respect to the invention recited in claim 2, the advantageous effect that the position of an adhesive surface having an adhesive resin layer is not easily shifted from the position of an adhered surface of an adhesion target even after heating and curing is achieved. Specifically, the adhesive composition according to the present invention does not substantially generate any volatile matter in heating for curing. This prevents an adhesion position from being shifted from its original position due to generation of a volatile matter in the heating for curing.

In view of the above, consideration and allowance are respectfully solicited.

In the event the Examiner believes an interview might serve in any way to advance the prosecution of this application, the undersigned is available at the telephone number noted below.

Application No.: 10/528,153

Docket No.: 27604-00003-US1

The Office is authorized to charge any necessary fees to Deposit Account No. 22-0185, under Order No. 27604- 00003-US1 from which the undersigned is authorized to draw.

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BAA/prb

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